

REMARKS

Applicant respectfully requests reconsideration of this application, and reconsideration of the Office Action dated November 22, 2004. Upon entry of this Amendment, claims 1-7, 10-16, 19-22 and 43-46 will be pending in this application. The changes to the claims are supported by the specification and original claims (e.g. page 21, lines 22-23). No new matter is incorporated by this Amendment.

Applicant notes the Information Disclosure statement that was filed November 15, 2004 (five days before the Office Action). Applicant requests that a signed copy of the corresponding PTO Form-1449 be returned with the next Office Action.

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Claims 1-7, 10-16, 19-22 and 43-46 are rejected under 35 U.S.C. § 102(b) as anticipated by Ohnishi et al. (U.S. Pat. No. 4,196,967). The Office Action asserts Ohnishi describes each feature of the claims either directly or inherently. Applicant respectfully traverses.

As an initial matter, Applicant notes the Office Action asserts, “the method steps consist of the broad steps of “forming”, “coating” etc and therefore these steps would be inherently satisfied by the apparatus of the reference as modified (emphasis added).” Applicants submit that for a rejection to be proper under 35 U.S.C. 102, each feature of the claim must be disclosed in the single document without being modified. See MPEP § 706.02(a), Distinction Between 35 U.S.C. 102 and 103. In other words, because Ohnishi would need to be modified to meet the active method steps, Ohnishi cannot be properly applied under 35 U.S.C. 102.

Independent claim 1 (from which claims 2-7, 19-22 and 43-46 all ultimately depend) concerns an optical lens. The lens includes a marking formed on a surface entirely outside a light transmitting effective area of the lens. Independent claim 10 (from which claims 11-16 depend) concerns a manufacturing method of such an optical lens. The

method accordingly includes a step of entirely forming a marking on a surface outside a light transmitting effective area of the lens.

The Office Action asserts feature 2a corresponds to a marking that is outside an effective area of the Ohnishi lens. However, as can be seen in the Figures, the lens described by Ohnishi transmits light even in the marked area. According to Applicant, although lens 2 in Fig. 1 of Ohnishi is of a partial reflection type, lens 2 itself transmits light in the area where the marking 2a is formed. This is because light introduced from the front penetrates the lens 2 and reflects at the marking 2a (formed at the back side of the lens 2) to advance forward. With respect to amended claims 1 and 10, and how the “effective area” is defined as an area for transmitting light, the marking 2a in Ohnishi is formed not outside but rather inside the effective area. Thus Ohnishi is completely different from Applicant’s lens where the marking is formed on a surface entirely outside a light transmitting, “effective area” of the lens. Hence, for at least this reason, Ohnishi fails to teach or fairly describe every feature of the independent claims.

In view of the above remarks, Applicant respectfully submits that the rejection is overcome. Hence, reconsideration and withdrawal of this rejection is requested.

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Applicant respectfully submits that this Amendment and the above remarks obviate the outstanding objection and rejection in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033216.068.

If an extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033216.068.

Respectfully submitted,
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